

## **RESPONSE**

Claims 5 and 47 are canceled without prejudice. Claim 1 has been amended to incorporate all the additional limitations of claim 5. Claim 44 has been amended to recite a method of performing in vivo examination of a mammalian body using the body-insertable apparatus recited by amended claim 1. Claims 45-47, 49-53, 59, 64, 66, 68-72, 82-85, and 88 have been amended to correct formal matters. All amendments are supported by the claims as originally filed and the Specification. No new matter is added by these amendments.

### **Double Patenting**

Claim 1 has been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 11 of U.S. Patent No. 6,289,229 B1. Without acquiescing to the Examiner's rejection, Assignee of the present application hereby attaches an executed Terminal Disclaimer over U.S. Patent No. 6,289,229 B1, along with a copy of "Limited Authorization to Act on Behalf of Assignee Regarding Certain Patent Matters" showing authority of the person signing the Terminal Disclaimer. Accordingly, Applicant respectfully submits that the double patenting rejection has been overcome and requests withdrawal of the rejection.

### **Rejections Under 35 U.S.C. § 112**

Claims 45-47, 49-53, 64, 66, 68-74, 82-86, and 88 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Office Action states that these claims fail to contain any method step while depending from a method claim.

Applicant has amended claims 45-47, 49-53, 64, 66, 68-72, 82-85, and 88 such that each one of these claims has been rewritten to contain a method step. Applicant further submits that each of claims 73, 74, and 86 already recites its limitations in the form of a method step, and requires no amendment in this regard. Accordingly, Applicant respectfully submits that all the

rejections under 35 U.S.C. § 112, second paragraph, have been either overcome or do not apply, and requests their reconsideration and withdrawal.

### **Rejections Based on Prior Art**

Amended claims 1 and 44 are the only independent claims that are pending. Claims 1 and 44, and some of their dependent claims have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,833,603 to Kovacs *et al.* ("Kovacs"). Some other dependent claims have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kovacs. However, the Office Action indicates that claims 2-10, 12, 13, 17-19, 45-47, 49-56, 64, 65, 75-79, and 81-86 are directed to allowable subject matter.

Without acquiescing to the above rejections based on prior art, Applicant has amended claim 1 to incorporate all the additional limitations of claim 5, which is, in turn, among the claims indicated as directed to allowable subject matter. Therefore, amended claim 1, which is practically claim 5 rewritten in independent form, should be allowable over cited references including Kovacs.

Claim 44 has been amended to recite a method of performing in vivo examination of a mammalian body using the body-insertable apparatus recited by amended claim 1. Since amended claim 1 is allowable over cited references including Kovacs, Applicant respectfully submits that amended claim 44 should also be allowable over cited references including Kovacs. Accordingly, amended claims 1 and 44, and their respective dependent claims, (i.e., all the pending claims), are allowable over the cited prior art references, and all the rejections under 35 U.S.C. §§ 102 and 103, should be reconsidered and withdrawn.

### **CONCLUSION**

After the entry of this paper, claims 1-4, 6-24, 26-32, 44-47, and 49-88 are pending and presented for reconsideration. Based on the amendments made to the claims, as well as remarks made herein, Applicant respectfully submits that all the pending claims are in condition for allowance, and requests that the claims proceed to early allowance.


If the Examiner believes that a telephone conversation with Applicant's attorney would expedite allowance of this application, the Examiner is cordially invited to call the undersigned attorney at (617) 248-7808.

Respectfully submitted,

Date: May 22, 2003  
Reg. No. (Limited Recognition)

Tel. No.: (617) 248-7808  
Fax No.: (617) 248-7100

TH&T\1002\515.2623083\_1

  
\_\_\_\_\_  
Duan Wu  
Attorney for Applicant  
Testa, Hurwitz, & Thibault, LLP  
High Street Tower  
125 High Street  
Boston, Massachusetts 02110